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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO:	CONFIRMATION NO.
09/179,332	10/27/1998	PHILIP BATES	CCCUSA3.0-00	5557

7590

09/24/2004

WARD & OLIVO
708 THIRD AVENUE
NEW YORK, NY 10017

EXAMINER

GECKIL, MEHMET B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/179,332

Applicant(s)

BATES ET AL.

Examiner

Mehmet B. Geckil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-52 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 30-52 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 30-49 are presented for examination.
2. Claims 30-49 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention as evidenced by the invoice and submitted information. This establishes an "on sale" bar to the claimed invention.

Claim Rejections - 35 U.S.C. § 102 - On Sale

The disclosed communications between "C-C-C Group" and "Customer Corporation" are evidence of actions that bring the claimed invention within the scope of a bar to patenting under 35 U.S.C. § 102(b).

In response to applicant's contention that there was no commercial offer for sale the Examiner notes:

- a. The affidavit of Philip Bates indicated that the system specifications were complete prior to the critical date. Thus it was "ready for patenting" as per the standard set out in Pfaff v Wells Elecs., Inc., 525 U.S.P.Q.2d 1601,1647.
- b. Applicant's reference to "meeting of the minds" is an outdated 17th century concept which has been rejected by both the modern common law and the Uniform Commercial Code [hereinafter UCC]. The standard for determining whether a contract has been formed is an objective one - whether an ordinary observer would find a contract based on outward objective manifestations of the parties.
- c. The UCC is designed to deal with the real world of contract formation. That is, a contract may be formed despite the absence of key terms. The UCC provides guidance as to how the unspecified terms will be ascertained. (See UCC § 2-204, 1-205 and 2-305 et. seq.)
- d. In the instant case the invoice states "payment will be due upon presentation of project schedule...". This indicates an agreement with obligations upon both parties. C-C-C must provide the listed items and Customer must pay the first deposit. There is even a date of delivery for the documents specified in the invoice.

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e. Mr. Morrison's declaration states that he did not regard the paperwork generated as an offer capable of acceptance. **In response,**

i. The subjective intent of Mr. Morrison is not dispositive as to whether a proper offer was in fact made. The basis of contract formation is the reasonable expectations created by the actions of the parties. Learned Hand's oft-quoted formulation was delivered in Hotchkiss v. National City Bank, 200 F.287,293 (S.D.N.Y. 1911):

A contract has strictly speaking, nothing to do with the personal, or individual, intent of the parties. A contract is an obligation attached by the mere force of law to certain acts of the parties, usually words, which ordinarily accompany and represent a known intent. If, however, it were proved by twenty bishops that either party, when he used the words, intended something else than the usual meaning which the law imposes upon them, he would still be held,...

ii. the declaration from the assignee is self-serving and thus has little probative value.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over

EXHIBIT 1.

6. Facsimile message shown on EXHIBIT 1 (dated September 29, 1996) taught the claimed invention substantially as claimed including a system for interfacing a plurality of server computers with output and input devices at a plurality of user locations, the system basically comprising three components:

- a) a switch as shown in the center of the faxed figures;
- b) a control circuit or supervisory computer system as shown in the figures as "C-C-C-SERVER" which is connected to the user to receive user inputs and is also connected to the switch and to a helper computer; and
- c) a helper PC as shown on the lower right hand side of the drawings wherein the helper PC is connected to the switch and the control circuit or supervisory server.

This system architecture is clearly set forth in the figures. According to the information written on the first page, the system will further have the following capabilities:

- i) the supervisory server will receive the initial keystrokes from the user and must provide a response to the user, e.g. a video must be generated as pointed out at subsection iii on the first page of EXHIBIT 1 (e.g. page 4/15 of the faxed document);
- ii) in response, the supervisory computer system will connect to the next free helper PC (subsection v). The connected helper PC will be running an application program and the user will interact with this application program (subsection v). This application program will help the user to connect to the required server (subsection v and helper PC specification disclosed on pages 13/15 and 14/15 of the faxed document.)
- iii) Only difference in the claim language and the faxed information is the recitation of the helper codes in the input signals but according to the faxed information this is no more than a request for a connection to a specific server. Therefore, it would have been obvious to one of ordinary skill in the network monitoring art at the time of the invention that the claimed invention differed from the disclosed faxed information only by a degree.

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7. In the response applicant argued that as of October 14, 1996, i.e., sending of the "invoice" does not constitute existence of an offer because as of that date only fragments and the whole system was available. Examiner respond to this argument is the saying of the affidavit of Philip Bates which indicated that the system specifications were complete prior to the critical date. Thus it was "ready for patenting" as per the standard set out in Pfaff v Wells Elecs., Inc., 525 U.S.P.Q.2d 1601,1647. Applicant further argued that whether the system as contemplated in the proposal (Morrison Decl. Exh. 1) could ever be made to operate satisfactorily in its intended environment is speculative at best. Pfaff stated the following regarding the condition that must be satisfied before the critical date: "That condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." The condition recited in the Pfaff was satisfied here because prior to the critical date the inventor had prepared drawings or other descriptions of the invention and faxed it to the customer. These faxed documents comprising the Exhibit 1 included drawings and other information, e.g. written description of the main system components were sufficiently specific to enable one of ordinary skilled in the art to practice the invention before the critical date. Applicant also argued that there was no offer for sale because the Official Action misinterpreted the invoice relied upon somehow stating an obligation of CCC to provide "listed items" by October 28 and an obligation of Customer Corp. to pay upon such presentation. Examiner states that in the instant case the invoice states "payment will be due upon presentation of project schedule...". This indicates an agreement with obligations upon both parties. C-C-C must provide the listed items and

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Customer must pay the first deposit. There is even a date of delivery for the documents specified in the invoice. Thus, it constitutes an "offer for sale."

8. New set of claims 30-49 are no more than rearranging and renaming some of the claim language of old claims 1-29. E.g., old claim 8 is now introduced as claim 30 with modification that server computer now becomes "remote devices", supervisory computer now becomes "control circuit" and helper computer now becomes helper circuit and the helper circuit is brought into the switch paragraph from the supervisory computer paragraph. The old claim 21 is now introduced as new claim 37. Old claim 21 recited server computer, the new claim 37 changes the server computer to "remote devices". Old claim 21 recites "ports" and the new claim 37 changes ports to "interface circuits." Old claim 28 now introduced as new claim 43 with old server computers language changed to "remote devices". Therefore the 103 rejection still applies to present claims. In order to keep track of the old arguments and responses (and to help the new attorney in the case) Examiner will repeat the previous record alive in this action. I.e., the following: Regarding to 103 rejection applicant argued in the previous action that in the claimed invention the helper codes allows the connection to the helper computer to be initiated at any time, whether or not the user is currently connected through the switch to another computer or server and by contrast in the Bates Declaration Exhibit 1, any keystroke sent by an inactive user causes connection to the helper PC. Examiner cannot see any claim language that reads anything like the applicant is arguing, e.g. "...be initiated at any time, whether or not the user is currently connected through the switch to another computer or server." As far as Examiner can see the function of the helper codes are no more than a request for a connection to a specific

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server. Therefore, it would have been obvious to one of ordinary skill in the network monitoring art at the time of the invention that the claimed invention differed from the disclosed faxed information only by a degree.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jack Harvey, can be reached on (703) 305-9705. The fax phone numbers for the organization where this application or proceeding is assigned are listed hereinbelow.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700. Customer service number is (703) 306-5631.

Any response to this action should be mailed to:

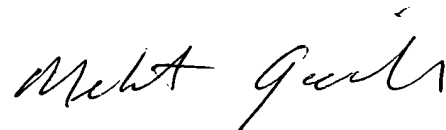
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

9/23/04



MEHMET B. GECKIL
PRIMARY EXAMINER